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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,996	11/24/2003	Hideyuki Kikuchi	2500.68761	3391

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EXAMINER

RENNER, CRAIG A

ART UNIT PAPER NUMBER

2652

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/720,996

Applicant(s)

KIKUCHI ET AL

Examiner

Craig A. Renner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 24 November 2003.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of "Group II (claims 5-9)" in the reply filed on 26 November 2004 is acknowledged. The traversal is on the ground(s) "that the Examiner has not established that the identified combination and subcombinations are distinct under Section 806.05(c) of the MPEP, and because no serious burden would be imposed on the Examiner to examine all of the claims together." This argument, however, is not found to be persuasive because the inventions are distinct for the reasoning given in paragraph 2 of the Office action dated 21 October 2004. Contrary to applicant's assertions, dependent claims may be used as evidence to establish that the inventions are distinct. Furthermore, the search for the invention of group II is not coextensive with the search for the inventions of groups I and III as evidenced by their different classifications, detailed in paragraph 1 of the Office action dated 21 October 2004. Therefore, searching for the inventions of all groups could not be done without serious burden.

The requirement is still deemed proper and is therefore made FINAL. Accordingly, claims 1-4 and 10-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to one or more non-elected inventions/species, there being no allowable generic or linking claim.

***Priority***

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Although the transmittal letter filed 24 November 2003 includes the specific reference to the prior application(s), the transmittal letter is not an enterable amendment as it is not in compliance with 37 CFR 1.121(h), which requires that "Each section of an amendment document (e.g., amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet." Moreover, see the question & answer under heading F6 on the following web page:

<http://www.uspto.gov/web/offices/pac/dapp/revised121qnas.htm>

***Drawings***

3. The drawings were received on 24 November 2003. These drawings are accepted.

***Specification***

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 5-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Katsumata et al. (US 6,377,411).

Katsumata et al. (US 6,377,411) teaches a head suspension assembly comprising a head suspension (30) supporting a head slider (36) at the tip end; and a dedicated read IC chip (34, lines 8-10 in column 7, for instance) located on the head suspension (as shown in FIGS. 2-3, for instance) and connected to a read element (32/321) on the head slider [as per claim 5]; wherein the head suspension assembly further comprises a dedicated write IC chip (53, lines 15-18 in column 7, for instance) located at a position spaced from the head suspension (as shown in FIG. 1, for

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instance) and connected to a write element (32/322) on the head slider [as per claim 6]; wherein length of a wiring connecting the read element to the dedicated read IC chip is set shorter than length of a wiring connecting the write element to the dedicated write IC chip (as shown in FIGS. 1-4, for instance) [as per claim 7]; and wherein the dedicated read IC chip is located closer to the head slider than the dedicated write IC chip is (as shown in FIGS. 1-4, for instance) [as per claim 8].

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katsumata et al. (US 6,377,411).

Katsumata et al. (US 6,377,411) teaches the head suspension assembly as detailed in paragraph 6, supra, further wherein the read element is magnetoresistive

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element (lines 50-51 in column 5, for instance). Katsumata et al. (US 6,377,411), however, remains silent as to the magnetoresistive element being a tunnel-junction magnetoresistive element.

Official notice is taken of the fact that a tunnel-junction magnetoresistive element is a notoriously old and well known magnetoresistive element configuration in the art. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have had the magnetoresistive element of Katsumata et al. (US 6,377,411) be a tunnel-junction magnetoresistive element. The rationale is as follows:

One of ordinary skill in the art would have been motivated to have had the magnetoresistive element of Katsumata et al. (US 6,377,411) be a tunnel-junction magnetoresistive element since such is a notoriously old and well known magnetoresistive element configuration in the art, and since selecting a known magnetoresistive element configuration on the basis of its suitability for the intended use is considered to be within the level of ordinary skill in the art.

#### ***Pertinent Prior Art***

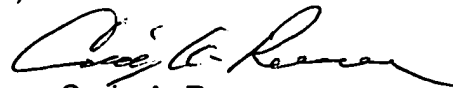
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This includes Katsumata et al. (EP 1 014 342 A2) and Katsumata (JP 2003-077233), which each individually teaches a head suspension assembly comprising a head suspension supporting a head slider at the tip end, and a dedicated read IC chip located on the head suspension and connected to a read element on the head slider.

**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig A. Renner whose telephone number is (571) 272-7580. The examiner can normally be reached on Tuesday-Friday 9:00 AM - 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Craig A. Renner  
Primary Examiner  
Art Unit 2652

CAR